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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,843	12/27/2000	Taira Hanaoka	14196	6311
23389	7590	12/01/2004		
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530				
EXAMINER CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,843

Applicant(s)

HANAOKA ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This action is responsive to the paper(s) filed 9/16/04.

#### *Claim Rejections - 35 USC § 103*

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al (418) (US6546418) in view of Dougherty et al (US6587859).

15 Regarding claims 1, 3, 6, Schena et al (418) teaches methods and apparatus for scanning printed codes (such as barcode images) which are processed by an extraction element which decodes an associated URL that is used to retrieve advertising information over a network and display it to the user on the apparatus [abstract, 6:19-21]. Schena et al does not teach displaying the scanned image. Schena et al does  
20 teach scanning the codes for immediate or delayed processing or for reference and that the links may be collected, sorted and prioritized [10:7-12, 43-47]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the history of scanned links as bookmarks so that a user could recall the collection of stored links for future reference, as is well known with bookmarking websites. Dougherty et al also  
25 teaches scanning physically printed code in a publication whereby scanning the code with an optical scanner directs the user to a website for more information [abstract, fig

10, 4:54-67, 5:1-6]. Dougherty et al teaches that the codes may have machine readable content as well as human-readable image content that indicates the destination content and/or destination format. It would have been obvious to one of ordinary skill at the time of the invention to have included the image content within the machine-scannable code

5 so that the links are more user-friendly and users can determine what content is available at the destination. It would have been obvious to one of ordinary skill at the time of the invention to have displayed such image-embedded "multicon linkmarks" on the display so that the suggested collection of stored bookmarks could be identified and selected for future reference. Regarding the title information, Schena et al (418)

10 teaches that the encoded information may include the destination URL as well as other information such as a trademark, product name, provider-defined information or information regarding the source of the advertisement link (i.e. July issue of XYZ magazine) [6:23-64]. Such information can be taken to be titles/descriptions regarding the specified advertising page/url/product. Official Notice is taken that it is well known

15 that title information is stored with bookmarked web addresses and it would have been obvious to one of ordinary skill at the time of the invention to have decoded and stored any type of descriptive title with each of the suggested web bookmarks so that a user can effectively manage, browse and select particular bookmarks by relying on such title information. Such would be an obvious way to enable users to "collect, sort and

20 prioritize" [10:43-46] bookmarked ad links of Schena et al (418).

Regarding the claim 1 preamble, no limitation is provided in the body of the claim to require "portable"; the language in the preamble is not taken to breathe life into the

claim and is not taken as limiting. Nonetheless, the apparatus of Schena et al (418) is taken to be "portable" and capable of being moved.

Regarding claims 4, 5, 7, Schena et al (418) teaches the use of a network url to display advertising on a web page [9:1-5]. The printed publication that includes the  
5 coding is taken to provide an article. The displayed content may be video [2:30-56].

Regarding claims 8-11, 13, 14, Schena et al (418) teaches that displayed ads are tracked for billing purposes. It would have been obvious to one of ordinary skill at the time of the invention to have provided an accounting server with charge table (database) to keep track of the billing. Schena et al (418) teaches that the billing may  
10 be based on the advertising selected and the number of impressions (access number). Official Notice is taken that it is well known to charge for advertising based on other functions such as time of day, the referring article content and the type of ad. It would have been obvious to one of ordinary skill at the time of the invention to have based advertising billing on any of these methods in order to charge the advertiser for the  
15 provided ads. Further, Schena et al (418) teaches sharing revenue/fees among all involved parties including bandwidth carrier (ISP provider), advertiser, content provider, etc. It would have been obvious to one of ordinary skill at the time of the invention to have charged the publisher for any portion of any required ISP connection charges so as to reduce/eliminate ISP connections charged for the user – a practice which is well  
20 known.

Regarding claim 12, Schena et al (418) teaches that the advertising/content displayed may be tailored to the user according to the user's location [7:15-20].

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***Response to Arguments***

Applicant argues that the instant invention provides encoded links and titles which are used to create bookmarks. Applicant argues that the user does not need to enter titles and can use them to easily select a bookmark. Consistent with the Official  
5 notice taken regarding bookmarks, associated titles are generally used to index and select stored bookmarks.

***Conclusion***

10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622